

REMARKS

As a preliminary matter, Applicants appreciate the Examiner's indication that dependent Claims 7-13 and 19 contain allowable subject matter, and would be allowed if amended into independent form. However, in light of the arguments made below, Applicants have opted not to amend Claims 7-13 and 19 into independent form at this time.

Claims 1-6 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 1,962,518 to Nessler. During a telephone conference with the Examiner on June 29, 2006, the Examiner added Claims 20 and 21 to this rejection. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Nessler reference fails to disclose all of the features of the present invention. More specifically, the Nessler reference fails to disclose a tibial sizer that includes, *inter alia*, "a channel extending along said tibial sizer in a longitudinal direction, through at least a portion of said head and at least a portion of said handle," as defined in Claim 1.

First of all, Applicants respectfully submit that the portion of the device of Figure 1 of the Nessler reference that the Examiner equated with the claimed channel (the portion supporting sliding gate 5) does not extend "in a longitudinal direction," as defined in Claim 1, but instead extends in a *transverse direction* with respect to the entire device. Applicants' Figure 2 shows one example of an embodiment of a device defined by Claim 1, and it can be clearly seen that channel 34 extends in the *longitudinal direction* of sizer 10. In

contrast, in Figure 1 of the Nessler reference, the portion supporting sliding gate 5 extends in the transverse direction of the device, which direction is actually perpendicular to the claimed longitudinal direction.

In response to the argument of the previous paragraph, the Examiner asserted that since he considers bracket 6 to be the handle, and he considers components 1, 2 and 3 to be the head, bracket 6 can be considered as extending longitudinally. *See* June 14, 2006 Final Office Action, pages 2-3. However, even assuming *arguendo* that the Examiner can consider bracket 6 as the handle and can also consider handle 2 as part of the head, when the device of Figures 1 and 2 of Nessler is considered as a whole, the portion that supports sliding gate 5 (which is the portion that most closely resembles a channel) still fails to extend in the longitudinal direction. This is the case because the term “longitudinal” means, in this context, “[o]f or relating to longitude or length,” and the term “length,” in this context, refers to “[t]he measurement of the extent of something along its greatest dimension.” *See* The American Heritage Dictionary of the English Language; Fourth Edition, 2000 (copies of relevant entries enclosed). As can be seen from a review of Figures 1 and 2 of Nessler, the longest dimension of the device extends along handle 2 and prongs 3, and the dimension in the direction that bracket 6 extends is shorter than the dimension along handle 2 and prongs 3. Thus, since the “longitudinal” direction, by definition, refers to the longest dimension, which is in the direction along the handle 2 and prongs 3, merely considering bracket 6 as the handle does not render the direction that the bracket 6 extends the longitudinal direction

because the dimension in this direction is shorter than the dimension along the handle 3 and prongs 3. Accordingly, by definition, bracket 6 cannot be considered as extending in the longitudinal direction, and therefore the Nessler reference lacks the claimed channel that extends “in a longitudinal direction,” as defined in independent Claim 1. For at least this reason, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 1 and associated dependent Claims 2-6, 20 and 21.

Additionally, Applicants respectfully submit that the portion of the device of Figure 1 of the Nessler reference that the Examiner equated with the claimed channel (the portion supporting sliding gate 5) also fails to extend “through at least a portion of said head and at least a portion of said handle,” as also defined in Claim 1. Applicants’ Figure 2 shows one example of an embodiment of a device defined by Claim 1, and it can be clearly seen that channel 34 extends through at least a portion of the head 12 and at least a portion of the handle 14.

In contrast, the device of Figure 1 of the Nessler reference lacks a channel that extends through at least a portion of both the head and the handle, as defined in Claim 1. In the Office Action, the Examiner appears to have equated thin plate 1 of Figure 1 of the Nessler reference with the claimed head, and to have equated bracket 6 with the claimed handle. However, the hollow portion of bracket 6 (which the Examiner appears to have equated with the claimed channel) does not extend through at least a portion of thin plate 1, as recited in Claim 1. Applicants respectfully submit that there is no portion of thin plate 1

that can be considered as the claimed “channel” because this component lacks a long gutter or groove within which the slider is configured to be slidably positioned. Instead, prong 3 of plate 1 is merely a thin plate, without any channel.

In the Final Office Action (page 3, lines 2-8), the Examiner has pointed out how there is a channel in bracket 6, on which point Applicants are in agreement with the Examiner. However, assuming *arguendo* that bracket 6 is considered as the handle, the head (which, as asserted by the Examiner refers to elements 1-3) still lacks a channel, as defined in Claim 1 (“a channel extending . . . through at least a portion of said head and at least a portion of said handle”). As mentioned above, elements 1-3 of Nessler are composed of a thin plate, and there is no disclosure that prong 3, which is crossed by gate 5, includes any type of gutter or groove which could be considered as the claimed channel that is in “at least a portion of the head,” as recited in Claim 1. Thus, for at least this reason also, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 1 and associated dependent Claims 2-6, 20 and 21.

Applicants also separately traverse dependent Claims 4, 20 and 21. More specifically, Applicants traverse the rejection of dependent Claim 4 because the device of Nessler lacks a head with posterior, lateral and medial outward peripheral surfaces that correspond to similar surfaces of a tibial base plate of a unicompartmental knee prosthesis. The device of Nessler is a hair gathering device, and has nothing to do with a knee prosthesis, or even with orthopedic implants in general. Accordingly, there is no disclosure

in the Nessler reference that thin plate 1 should be shaped to correspond to a tibial base plate. The language of Claim 4 is not functional language or a statement of intended use, but it is instead structural language that defines the shape of the head. Thus, the language of Claim 4 must be considered and accorded full patentable weight. Accordingly, for this reason also, Applicants respectfully request the withdrawal of this §102(b) rejection of dependent Claim 4.

Applicants traverse the §102(b) rejection of dependent Claim 20 because the Nessler reference fails to disclose a tibial sizer that includes a channel with “a pair of upper lips, in at least a portion of said head and at least a portion of said handle, for maintaining said slider within said channel,” as defined in dependent Claim 20. One example of an embodiment of the claimed sizer is shown in Applicants’ Figure 3, which is a cross-sectional view that shows upper lips 36, which maintain slider 16 (Figure 4) within channel 34.

In contrast, the device of the Nessler reference fails to include such a “pair of upper lips, in at least a portion of said head and at least a portion of said handle, for maintaining said slider within said channel.” More specifically, if the Examiner is considering components 1-3 as the head in the Nessler reference, there is no section of this “head” portion that can be interpreted as the claimed “pair of upper lips” because components 1-3 are all made from a single, flat, thin plate. Accordingly, for at least this additional reason, Applicants respectfully request the withdrawal of this §102(b) rejection of dependent Claim 20.

Applicants traverse the §102(b) rejection of dependent Claim 21 because the Nessler reference fails to disclose a tibial sizer that includes a channel that “extends through the entire length of said tibial sizer.” Applicants’ Figure 2 shows one example of an embodiment in which channel 34 extends through the entire length of the tibial sizer. In contrast, even assuming *arguendo* that the length direction of Nessler can be considered as extending along sliding gate 5, there is no component that can be considered as the claimed channel that “extends through the entire length of the tibial sizer,” as defined in dependent Claim 21. As can be seen in Figures 1 and 2 of Nessler et al., the aperture in bracket 6, which is the component that most closely resembles the claimed “channel” only extends through bracket 6, without extending through either of the prongs 3. Thus, for at least this additional reason, Applicants respectfully request the withdrawal of this §102(e) rejection of dependent Claim 21.

As discussed during the telephone conference with the Examiner on June 29, 2006, Claims 17 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over United States Patent No. 1,962,518 to Nessler in view of United States Patent No. 4,211,228 to Cloutier. Applicants respectfully traverse this rejection.

Applicants respectfully traverse this rejection because: (1) Applicants respectfully submit that one of ordinary skill in the art would not have combined Nessler with Cloutier; and (2) even assuming *arguendo* that the Examiner’s proposed combination was

proper, the resulting device still fails to include all of the claimed features of the present invention.

First, Applicants respectfully submit that one of ordinary skill in the art would not have combined Cloutier with Nessler because the two devices are used for different purposes, and an artisan skilled in one area would not be familiar with the other area. The device of Nessler is intended to be used to determine the volume of hair grown in a certain region of the scalp. In contrast, the device of Cloutier is to be used by an orthopedic surgeon during surgery to determine the location of a tibial prosthesis component. Thus, the devices of Cloutier and Nessler are used by different groups of people; by people of different skill levels and areas of expertise; for measuring different areas (a resected tibia vs. hair); in different environments; and for different purposes (to determine the location of a tibial component of a prosthesis vs. determining the volume of hair in a specific area of the scalp size). Thus, due to all these differences, Applicants respectfully submit that one of ordinary skill in the art of would not have looked to the tibial template of Cloutier to modify the hair measuring device of Nessler. Accordingly, for at least this reason, Applicants respectfully request the withdrawal of this §103 rejection of Claims 17 and 18.

In response to the Examiner's assertion of page 3 (lines 20-22) of the Final Office Action that the device of Nessler is "capable of use with multiple plates, as disclosed by Cloutier '228 (Col. 2, lines 16-209)," the Examiner is reminded that merely being "capable" of being used or modified in a certain way is not a sufficient basis for a §103

rejection. More specifically, it is well established that a §103 rejection requires that there be a motivation to modify the cited reference to arrive at the claimed invention. *See e.g., Ex parte Levengood*, 28 USPQ2d, 1300, 1302 (Bd. App. Int. 1993) (“an examiner cannot establish obviousness . . . without also providing evidence of the motivating force which would impel one skilled in the art to do what the patent applicant has done.”) The Examiner’s statement that the device of Nessler “is capable” of use with multiple plates is exactly the type of statement that the Federal Circuit has concluded fails to supply the required motivation to modify a reference to support a §103 rejection. *See In re Mills*, 16 USPQ2d 1430, 1432, (Fed. Cir. 1990) (“While [the prior art] apparatus may be capable of being modified to run the way [the claimed] apparatus [runs,] there must be a suggestion or motivation in the reference to do so.”) Thus, as the Examiner has not provided the required motivation to modify the device of the Nessler reference in light of the Cloutier reference, Applicants respectfully request the withdrawal of this §103 rejection of Claims 17 and 18 for at least this reason.

Secondly, even assuming *arguendo* that Cloutier could be combined with Nessler, the resulting combination still fails to include all of the features of independent Claim 17. More specifically, the references of the proposed combination of Nessler and Cloutier do not disclose or suggest a system of tibial sizers, where each sizer includes “a channel extending along said tibial sizer in a longitudinal direction, through at least a portion of said head and at least a portion of said handle,” as defined in independent Claim 17. In the

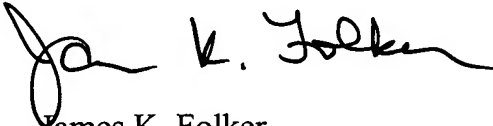
section responding to the §102(b) rejection of Claims 1-6, 20 and 21 under Nessler, Applicants discussed how the Nessler reference lacks this feature. Additionally, the Cloutier reference does not include this feature either, nor was it relied upon as such by the Examiner. Accordingly, for this reason also, Applicants respectfully request the withdrawal of this §103 rejection of independent Claim 17 and associated dependent Claim 18.

Additionally, the proposed combination of Nessler and Cloutier also lacks “a slider configured and arranged to be slidably positioned within each of said channels of said plurality of differently sized tibial sizers” (emphasis added), as recited in Claim 17. Use of a single slider with multiple differently sized sizers reduces the cost of the system because only a single slider is required to be manufactured, instead of manufacturing a different slider for each of the multiple differently sized sizers. There is no disclosure or suggestion in Nessler or in Cloutier to even make the apparatus of Nessler of different sizes, let alone the more specific disclosure or suggestion to make sliding gate 5 of Nessler to be capable of fitting within differently sized apparatuses. Accordingly, for this reason also, Applicants respectfully request the withdrawal of this §103 rejection of independent Claim 17 and associated dependent Claim 18.

For all of the above reasons, Applicants request reconsideration and allowance of the claimed invention. Should the Examiner be of the opinion that a telephone conference

would aid in the prosecution of the application, or that outstanding issues exist, the Examiner is invited to contact the undersigned.

Respectfully submitted,
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The American Heritage® Dictionary of the English Language: Fourth Edition. 2000.

longitudinal

SYLLABICATION: lon-gi-tu-di-nal

PRONUNCIATION:  lɒnˈdʒiːˈtʊdɪˈnəl, -ˈtʊdɪˈ-, lɒnˈ-

ADJECTIVE: **1a.** Of or relating to longitude or length: *a longitudinal reckoning by the navigator; made longitudinal measurements of the hull.* **b.** Concerned with the development of persons or groups over time: *a longitudinal study of twins.* **2.** Placed or running lengthwise: *longitudinal stripes.*

OTHER FORMS: lonˈdʒiːˈtuːdiˈnəl·ly —ADVERB

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length

PRONUNCIATION:  lĕngkth, lĕngth, lĕnth

- NOUN:** 1. The state, quality, or fact of being long. See Usage Note at **strength**. 2. The measurement of the extent of something along its greatest dimension: *the length of the boat*. 3. A piece, often of a standard size, that is normally measured along its greatest dimension: *a length of cloth*. 4. A measure used as a unit to estimate distances: *won the race by a length*. 5. Extent or distance from beginning to end: *the length of a novel; the length of a journey*. 6. The amount of time between specified moments; the duration: *the length of a meeting*. 7. Extent or degree to which an action or policy is carried. Often used in the plural: *went to great lengths to prove his point*. 8. *Linguistics* a. The duration of a vowel. b. The duration of a syllable. 9. The vertical extent of a garment. Often used in combination: *knee-length; floor-length*.

IDIOM: **at length** 1. After some time; eventually: *At length we arrived at our destination*. 2. For a considerable time; fully: *spoke at length about the court ruling*.

ETYMOLOGY: Middle English, from Old English *lengthu*. See **del**¹ in Appendix I.

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